

### **REMARKS/ARGUMENTS**

This Amendment responds to the Office Action mailed November 27, 2006. Claims 1-7, 9, and 10 were pending prior to this amendment. Claims 11-41 previously were withdrawn as drawn to non-elected subject matter. No claims have been canceled or added. Claim 10 is amended herein. With this Amendment, Claims 1-7, 9 and 10 remain pending for further consideration.

#### **Claim Rejections**

Claims 1-3, 5 and 10 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Denison (U.S. Publication No. 2004/0049225 A1). Also, Claims 6 and 7 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Denison alone. Further, Claims 4 and 9 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Denison in view of Bagaoisan et al. (U.S. Patent No. 6,152,909). These rejections are improper in view of facts set forth in a declaration submitted herewith that shows that claimed embodiments of this application were invented prior to the earliest priority date, i.e., the filing date, of Denison. More particularly, a *Declaration by Mukund Patel Pursuant to 37 C.F.R. § 1.131* establishes an invention date for at least Claims 1, 2, 3 and 5 that predates the September 11, 2002, the earliest priority date of Denison. Because Claims 4, 6, 7, and 9 are deemed by the Examiner to be obvious in view of Denison alone or in combination with Bagaoisan, the *Declaration* also overcomes these rejections. See M.P.E.P. § 715.02.

Therefore, Applicants respectfully submit that Denison is not prior art applicable against at least Claims 1-7 and 9 of this application and that the rejection of these claims should be withdrawn.

As noted above, Claim 10 stands rejected under 35 U.S.C. § 102(e) as being anticipated by Denison. Applicants do not agree that this rejection is proper nor do Applicants concede that Denison predates Applicants' invention of Claim 10. Nevertheless, to expedite allowance, Applicants have amended Claim 10 to further distinguish Denison.

Denison discloses a dual lumen catheter (10) with an embolic protection device (30) slidably disposed within one of the lumens. The embolic protection device (30) "is a balloon occlusion catheter comprising an elongated shaft (31) defining an inflation lumen (32) in fluid communication with a balloon (33) on a distal end of the shaft (31)." Denison, ¶ [0020]. The balloon 33 of Denison is not mounted on the catheter 10. Furthermore, Denison requires that the


balloon (33) not be mounted on the catheter (10) because such mounting would prevent it from providing the distal protection function. For at least these reasons, Denison does not contain each limitation present in amended Claim 10. Applicant requests that the rejection of Claim 10 be withdrawn.

### CONCLUSION

Applicants respectfully submit that the claims are in condition for allowance. Furthermore, any remarks in support of patentability of one claim should not be imputed to any other claim, even if similar terminology is used. Any remarks referring to only a portion of a claim should not be understood to base patentability on that portion or that the limitation discussed is essential or critical; rather, patentability must rest on each claim taken as a whole. Applicants respectfully traverses each of Examiner's rejections and each of the Examiner's assertions regarding what the prior art shows or teaches, even if not expressly discussed herein. Although changes to the Claim 10 have been made, no acquiescence, disclaimer or estoppel is intended or should be implied thereby; such amendments are made only to expedite prosecution of the present application and are without prejudice to the presentation or assertion, in the future, of claims relating to the same or similar subject matter.

The Commissioner is hereby authorized to charge any additional fees which may be required under 37 C.F.R. 1.17, or credit any overpayment, to Deposit Account No. 01-2525. If the Examiner feels that a telephone conference would in any way expedite the prosecution of the application, please do not hesitate to call the undersigned at telephone (949) 760-0404.

Respectfully submitted,

  
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